BOX AF
33688US
Serial No. 09/255,213

Response Under 37 C.F.R. 1.116
Expedited Procedure
Examining Group: 1755

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Joel L. Martin

Serial No.: 09/255,213 Group Art Unit: 1755

Filed: 02/22/99 Examiner: J. Pasterczyk

For: CATALYST AND PROCESS FOR POLYMERIZING OLEFINS

PETITION UNDER 37 C.F.R. 1.144

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

The applicant through his undersigned attorney hereby requests that the restriction requirement that the Examiner has entered in this case be reversed.

The independent claim 1 of this case is directed to a catalyst system comprising the product resulting from the combination of a certain type of metallocene with a cocatalyst having an alkylaluminum functionality. Dependent

claim 11 is directed to a process for polymerizing an olefin which comprises combining the olefin with a catalyst system of the type set forth in claim 1.

On May 1, 2000, the Examiner called the undersigned attorney and required that an election be made between claims 1-10 and claims 11-18. The undersigned attorney elected claims 11-18 with traverse. In response to the following Office Action of July 5, 2000, the undersigned attorney requested that the restriction requirement be reconsidered and withdrawn.

In the Office Action of July 5, 2000, the Examiner asserted that the restriction requirement was proper since in his opinion "the process for using the product as claimed can be practiced with a materially different product, such as a Ziegler-Natta catalyst or a chromium oxide catalyst".

In the response filed on November 27, 2000, the undersigned attorney pointed out that it was improper to consider that the polymerization process of claims 11-18 could be practiced with a materially different product than that covered by non-elected claim 1. The process of the elected claims specifically requires the employment of a catalyst system of the type specified in the non-elected claims.

The final rejection of January 16, 2001, made the restriction requirement final. The Examiner, however, apparently ignored the applicant's argument regarding the fact that the elected process specifically requires the employment of the catalyst system of the non-elected claims.

It should be absolutely obvious that the elected claims and the non-elected claims are in fact directed to the same invention. It is the unexpected effect of the combination of the non-elected claims as a catalyst for the polymerization of olefins that makes both patentable.

The Examiner has not provided any assertion that the product of the non-elected claims could be used in a materially different process.

Even if the elected and non-elected claims were distinct inventions, it is submitted that this is a situation wherein the non-elected claims are linked to the elected claims and that therefore the non-elected claims should be considered unless the elected claims are found to be unpatentable.

As pointed out in section 808.02 of the MPEP "where... the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 112 is never proper...".

In view of the foregoing remarks, it is respectfully requested that the Examiner be directed to examine both the non-elected claims as well as the elected claims.

Respectfully submitted,

By _____
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on

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Edward L. Bowman